

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-19 are now present in this application. Claims 1 and 8 are independent. Claims 8-18 have been withdrawn from consideration. Claims 1, 4, 5, 7, 8, 13 and 16 have been amended. No new matter is involved. Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. §119

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. §119, and receipt of the certified priority document.

Reconsideration of the Restriction Requirement

Applicants have the right to file a Petition under 37 CFR §1.181 and 1.144 to the Group Director seeking to overturn the decision adhering to the restriction requirement and withdrawal of claims 8-18, which has been made final.

The substance of such a petition is included herein in the form of a Request for Reconsideration to expedite prosecution of the Application should the Examiner agree with the reasons presented, below, in this regard.

The reason for adhering to the restriction requirement, and the reason stated for the restriction requirement being proper, was that “[I]n the instant case the bearing could be made by a materially different process, using a different order of manufacturing than what is claimed by Applicant.” See page 2 of the February 6, 2003 Office Action.

Applicants respectfully submit that, in general, claims 8-18 do not specify a particular order of manufacturing. No order of performing the steps set forth in claim 8 is recited. Moreover, the Court of Appeals for the Federal Circuit has held, in Altiris Inc. v. Symantic Corp., 65 USPQ2d 1865 (Fed. Cir. 2003) that steps recited in a method claim need not be performed in the order in which they were written where the claim language did not indicate, either grammatically or logically, that a particular step must occur in a particular order compared to other steps.

Looking at claim 8 of this Application, it is clear that, logically, a shaft can be placed in a bushing before the bushing is processed or after it is processed. Moreover, the claim does not grammatically state which step occurs first. Similarly, applying a pre-pressure to a housing and sealing the housing can occur before or after a shaft is placed in a bushing.

Furthermore, if any of the steps have to take place in a logical order to result in an operative device, then the order of those steps cannot be changed to achieve a materially different invention because that invention would be

inoperative.

Additionally, the February 6, 2003 Office Action merely speculates that a different order of manufacture of the claimed invention would be materially different.

The burden is on the Examiner to make out a *prima facie* case that allegedly restrictable inventions are materially different, i.e., are independent and distinct. In this regard, MPEP §816 clearly states that the particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

However, no reasons were given in the February 6, 2004 Office Action to support the conclusion that changing the order of the steps recited in claims 8-18 would result in a material different invention than what is recited in those claims.

As a result, the restriction requirement does not make a *prima facie* case that claims 8-18 are independent and distinct from claims 1-7 and 19, the restriction requirement is improper, and it should be withdrawn.

Claim Amendments

Applicants have amended the claims in order to place them in more idiomatic English. The claim amendments are not being made in response to any statutory requirement for patentability, and have not been narrowed in scope. Instead, the claims have been amended merely to recite the subject matter therein more clearly.

Rejection Under 35 U.S.C. §102

Claims 1, 3, 4, 6, 7 and 19 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,871,285 to Wasson. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444(Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788(Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent.

A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently

(see, In re Paulsen, 30 F.3d 1475, 1478,1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

In this instance, Applicants respectfully submit that Wasson does not disclose “a housing containing a lubricant” or “a bushing placed in the housing having a plurality of dynamic pressure generating grooves that penetrate through the bushing for storing the lubricant.”

Wasson discloses, in Fig. 6 for example, a bearing 14 that has holes 15 through which fluid enters the bearing at high pressure – see col. 5, lines 29-44, for example. The fluid enters the bearing at high pressure from a pressurizing pumped source, which is not shown – see col. 4, lines 20-35, for example.

Wasson does not disclose any housing for bearing 14, for example, or for any disclosed bearing. The assertion in the Office Action that prior art bearing 1 of Wasson is a housing is simply not true. Bearing 1 in Wasson is merely a means of dispensing fluid pumped through it and does not serve as a housing for a bushing, as recited in these claims.

Wasson also does not disclose a bushing with a plurality of dynamic pressure generating grooves that penetrate through the bushing. Instead,

Wasson's bushing (bearing) only has holes, not grooves, that penetrate through the bushing.

Wasson also does not disclose a "bushing . . . for storing the lubricant," as recited. Wasson's bushing (bearing) does not store lubricant. Rather Wasson's bushing (e.g., bearing 14) merely dispenses fluid that is pumped to it at high pressure from a pressurizing pump source.

Further, the Office Action engages in speculation when it states that Wasson creates a pressure difference between the outside of the housing and the inside of the housing, causing the lubricant to flow into the grooves of the bushing.

As is well settled, a rejection must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection he advances. An Examiner may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis, see, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Moreover, should the Office Action be relying on the doctrine of inherency, the Examiner is respectfully reminded that "inherent anticipation requires that the missing descriptive material is 'necessarily present,' not

merely probably or possibly present, in the prior art.” Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599(Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

Because Wasson does not disclose a housing or the relationship of a housing to a bushing (bearing), the asserted disclosure is not necessarily found in Wasson.

With respect to claims 3 and 19, because Wasson does not disclose a housing, for reasons presented above, Wasson does not disclose a “pre-pressure” applied to the non-existent housing to make the lubricant pass through the grooves. Wasson clearly applies pressure to his bearing (e.g., bearing 14), but that bearing is not a housing as defined in the claims, and Wasson has no disclosure of a “pre-pressure.” The Office Action asserts that a pre-pressure is disclosed by Wasson in col. 4, lines 20-35. However, the pressure disclosed there is not a “pre-pressure.” Instead, Wasson’s disclosure is of pressure from a pump while the bearing is in operation, not preceding bearing operation.

With respect to claim 4, the Office Action does not point out where Wasson discloses a sealed unit, either explicitly or inherently (necessarily).

With respect to claim 7, it is noted that none of Wasson’s grooves penetrate through the bushing (bearing), as recited.

Accordingly, the Office Action has not made out a *prima facie* case of anticipation of the invention recited in claims 1, 3, 4, 6, 7 and 19 and should be withdrawn.

Rejections under 35 U.S.C. §103

Claims 2 and 5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wasson in view of U.S. Patent 6,250,807 to Mori et al. (hereinafter, "Mori"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444(Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788(Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent.

A rejection must be based on objective evidence of record, not merely conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

An Examiner may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis required to make a

proper rejection under the statutes, see, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

In rejecting claims under 35 USC §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification

obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). However, the suggestion to combine need not be express and "may come from the prior art, as filtered through the knowledge of one

skilled in the art.” *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489(Fed. Cir. 1997).

This rejection of claim 2 contains no statement of motivation to combine Wasson and Mori, or to modify Wasson in view of Mori. For this reason alone, the rejection is improper and should be withdrawn.

Moreover, the differences between these two references, which must be taken into consideration in evaluating the invention “as a whole” are not even mentioned, let alone taken into consideration.

In the first place, Wasson has a specific cylindrical bearing that is used to disperse fluid to a shaft and discloses that the fluid is provided to the bearing “at high pressure from a pressurized pump source through restricted orifices 8.” See col. 4, lines 20-22, for example. Wasson is directed to bearings for “many applications ranging from machine tool spindles to high-speed turbomachinery.” See col. 1, lines 41-43, for example.

In the second place, Mori is directed to different types of devices, i.e., to spindle motors in information equipment – see col. 1, lines 10-20, for example.

In the third place, Mori disclose no cylindrical bearing through which lubricating fluid is pumped at high pressures.

In the fourth place, Mori’s bearing is a porous body that contains a lubricant where the porous body directly touches the spindle shaft and directly applies the lubricant to the shaft from the porous material.

In the fifth place, Mori's grooves 23 do not penetrate through Mori's bearing 1, as do the grooves in Applicants' claimed invention. Mori's grooves are only indented into the sidewall of the bearing 1

Applicants respectfully submit that these significant differences teach away from combining these references in any manner.

In the sixth place, Wasson discloses no need for any modification of its high pressure pump lubricant supply system and Mori discloses no need to be modified.

Furthermore, even if these references were somehow combined (and Applicant submits that there is no proper motivation shown to do so), if one were to substitute Mori's porous bearing into Wasson, there would be no need to keep the cylindrical bearing of Wasson because it only dispenses the lubricant, whereas Mori's porous bearing stores and dispenses the lubricant. Such a reference combination would not render the claimed invention obvious.

As neither applied reference even suggests a separate cylindrical bushing with grooves that extend therethrough, coupled with a porous supply of lubricant, the motivation for modifying Wasson to include both positively recited features must be based on improper speculation and/or impermissible hindsight.

Accordingly, Applicants respectfully submit that the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention recited in

claim 2.

With respect to claim 5, Applicants have not found, and the Office Action does not state where Wasson discloses a sealed unit or a sealant, or glue in any capacity, or where Mori provides glue as a sealant. Yet the Office Action finds the claimed features recited in claim 5 as obvious based on the statement that it is old and well known to use glue in the art as a sealant.

This rejection is improper for several reasons, including the reasons presented above regarding the patentability of claim 4 from which claim 5 depends. It should be noted that the Office Action never discloses where Wasson discloses a seal, let alone a glue seal, or where Mori or Wasson disclose glue in any capacity, let alone as a seal.

As neither applied reference even suggests where Wasson discloses a seal, let alone a glue seal, which has not been demonstrated to work in Wasson's high pressure lubricant pump type system, and Mori does not disclose glue in any capacity, or a seal that is compatible with Wasson, the motivation for modifying Wasson to include the positively recited glue seal must be based on improper speculation and/or impermissible hindsight.

Additional Cited References

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Piecemeal Prosecution

Applicants respectfully note that this rejection is the third non-final Office Action and respectfully submit that if the aforementioned arguments are persuasive, that the Application should be allowed and not be subjected to further piecemeal prosecution.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

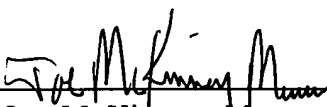
Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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